

REMARKS

Claims 2-7, 14, 16-18, 22-32 are pending in the application. The claims remain unchanged notwithstanding numerous rejections in the Office Action.

The following supposed errors are found in the Examiner's action.

1. The finality of the Office Action mailed July 7, 2003 should be withdrawn, because contrary to the Examiner's position, the new grounds of rejection presented in the Office Action were not necessitated by Applicants' amendments.

In the last Amendment, Applicants rewritten claim 2 in independent form and added "engagement" and "displacement" to the last two paragraphs of claim 2. These amendments are cosmetic and do not change the scope of claim 2. Similarly, the amendments made to claims 5, 6, and 14 are cosmetic and do not change the scope of these claims. Thus, the new grounds of rejection, i.e., the *35 U.S.C. 112, first paragraph* rejection of claims 2-7 and the *35 U.S.C. 103(a)* rejection of claims 2-4, were not necessitated by Applicants' amendments. Note, the finality of the Office Action might have been proper had the Examiner considered and rejected newly added claims 22-32. However, since the Examiner withdrew claims 22-32 from consideration, claims 22-32 do not provide basis for making the Office Action final. The finality of the July 7, 2003 Office Action should therefore be withdrawn.

Should the Examiner insist that Applicants' amendments necessitated the new grounds of rejection, **the Examiner is asked to identify the amended claim or claims that necessitated the new grounds of rejection.**

2. The restriction requirement is improper and should be withdrawn or at least rephrased.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) there must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). See MPEP, section 803.

The Examiner failed to demonstrate both points (A) and (B).

In paragraph 1 of the Final Office Action, the Examiner simply stated that “claims 22-32 are directed to an invention that is independent or distinct from the invention originally claimed, [because] it is directed towards a tool within a barrel assembly including two separate portions and a resilient element in between.”

This statement clearly fails to support the Examiner’s allegation that the invention of claims 22-32 is *independent of distinct* from the invention of the other pending claims. The Examiner’s statement also fails to demonstrate that there is a *serious burden* on the examiner. The Examiner is kindly reminded that if “the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” See MPEP, section 803 (emphasis added).

Accordingly, Applicants respectfully submit that the restriction requirement, *as formulated by the Examiner*, is improper and should be withdrawn or at least rephrased.

3. The *35 U.S.C. 112, first paragraph* rejection of claims 2-7 is improper and therefore traversed.

Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. For terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action. See Genentech v. Wellcome Foundation, 29 F.3d 1555, 1563-64, 31 USPQ2d 1161, 1167-68 (Fed. Cir. 1994). In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). See MPEP, section 2164.04 (emphasis added).

The Examiner failed to follow proper USPTO procedure and practice reproduced above.

First, the Examiner failed to construe the claims. It is noted that the rejected claims include means plus function language that should be interpreted under *35 U.S.C. 112, sixth paragraph*.

Second, the Examiner failed to meet the *initial burden* to provide a reasonable explanation as to why the scope of protection provided by the rejected claims is not adequately enabled by the disclosure. The Examiner's statement in paragraph 3 of the operating system is conclusory and evidentially unsupported. The Examiner's mere statement that the specification does not enable any person skilled in the art to make or use the claimed invention does not amount to a *reasonable explanation*.

The Examiner is asked to further clarify the 35 U.S.C. 112, first paragraph rejection to properly construe the rejected claims and provide a reasonable explanation as to why the scope of protection provided by the rejected claims is not adequately enabled by the disclosure

Once the Examiner has met the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention, Applicants will come forward with rebutting arguments and/or amendments.

4. The repeated 35 U.S.C. 102(e) rejection of claim 14 as being anticipated by *Hirtl* is traversed for the reasons advanced in the last Amendment paper which were not responded to by the Examiner.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. See MPEP, section 706.07 (emphasis added). Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. See MPEP, section 707.07(f).

In this case, the Examiner repeated the rejection of claim 14 without responding to Applicants' arguments in page 8 of the Amendment paper filed June 12, 2003. The Examiner clearly failed to follow proper USPTO procedure and practice reproduced above.

Applicants respectfully request that the Examiner specify the reason(s) why the 35 U.S.C. 102(e) rejection of claim 14 is sustained.

In addition, Applicants would like to bring the Examiner's attention to the fact that *Hirtl* fails to disclose, teach or suggest the claimed resetting mechanism that connects the barrel and the piston. Spring 23 of *Hirtl* which the Examiner regarded as part of a resetting mechanism is not described in the patent to connect barrel 4 and piston 6. The *Hirtl* barrel and piston are neither disclosed to be connected by any other means. The anticipatory of claim 14 should be withdrawn.

5. The 35 U.S.C. 103(a) rejection of claims 2-7 and 16-18 as being unpatentable over *Hirtl* in view of *Jochum* is traversed because the applied references singly or in combination fail to disclose, teach or suggest all limitations of the rejected claims.

The Examiner appeared to admit that *Hirtl* does not teach or suggest the last two limitations of independent claim 2, i.e., engagement means and displacement means. The Examiner then

stated that *Jochum* teaches the missing elements and held it would have been obvious to combine *Jochum* with *Hirlt* to provide for a gripping means for arresting returning the piston.

Applicants respectfully disagree, because *Hirlt* and *Jochum* do not disclose, teach or suggest the claimed **displacement means for displacing the engagement means rearwardly** and comprising an **energy source**. Contrary to the Examiner's position manifested in page 4, lines 6-10 of the July 7, 2003 Office Action, element 10 of *Jochum* is a ball (see Fig. 1, column 5, line 33 of *Jochum*) rather than an energy source, and the assembly ball 10/pad 11 of *Jochum* which the Examiner regarded as the claimed engagement means is not displaced rearwardly by any means. (the Examiner is asked to cite column and line numbers of *Jochum* if he holds otherwise). Thus, *Hirlt* in view of *Jochum*, as applied by the Examiner, fail to render the invention of claim 2 obvious.

Claims 3-7 are patentable at least for the reasons advanced with respect to independent claim 2.

Claims 16-18 are patentable at least for the reasons advanced with respect to independent claim 14. Claims 16-18 are also patentable over the applied references for the reasons advanced in the last Amendment, page 9.

In addition, as to claim 16, the applied references fail to disclose, teach or suggest a spring attached to the barrel and the catching element. The Examiner's catching element appears to be assembly 10/11 of *Jochum*. This assembly is not disclosed or suggested to be attached to any spring.

As to claim 17, the applied references fail to disclose, teach or suggest the claimed **latch**. The Examiner simply forgot to specify where in the applied references this claim feature might be found or suggested. **Clarification is respectfully requested.**

Accordingly, all claims in the present application are clearly in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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